

Remarks

Claims 1-21 and 23-45 are pending in this application. Claims 1-38 have been rejected as indefinite under 35 U.S.C. § 112, ¶ 2. All pending claims except for claim 34 were also rejected under 35 U.S.C. § 103(a) as obvious. Claims 39-41 and 43-45 were also rejected under 35 U.S.C. § 102(a) as anticipated.

Claim 1 has been amended to incorporate the limitations of claims 4 and 5 and clarify the claim, and claims 4 and 5 have been canceled. Claim 24 has been amended to clarify the claim. Claim 29 has been amended to correct a typographical error. Claim 34 has been rewritten in independent form. Claim 39 has been amended to further present patentable features of the claim. As a consequence, Applicants respectfully submit that all pending claims are in condition for allowance.

Applicants first respectfully submit that claims 39-41 and 43-45 are no longer anticipated. The amended claims now recite a claim specifically directed to an automotive navigation or multimedia system, and states that such limitation is a specific limitation of the claim. Further, the claims require that some of the data files contain map data. Neither of those features is found in the cited reference, Dietel. As such, the rejection under § 102 should be withdrawn. *See* MPEP § 2131 (anticipation requires each and every element of the claim be present in a single reference).

Neither are any of the remaining claims obvious. Obviousness requires that each and every element of a claim be present in a combination of references, along with a teaching,

motivation and suggestion of success in combining them. *See* MPEP § 2143.01. A modification to a reference is not obvious if it changes that reference's principle of operation. MPEP § 2143.01. In addition, a modification to a reference that renders the reference unsatisfactory for its intended purpose is not obvious. *Id.* In addition, the motivation to combine reference must be "clearly and particularly" taught in the references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Finally, in determining obviousness, the Examiner "cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies." *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Here, each of the rejections of remaining claims relies on a reference to Windows NT to teach asserted limitations. However, the Examiner has not pointed to any clear and particular teaching to adapt Windows NT to the automotive environment. Furthermore, Applicant has amended independent claims 1 and 24 to explicitly recite the positive limitation that the system and storage medium, respectively, is adapted to use in a motor vehicle. Thus, those limitations should be given patentable weight as they are no longer solely confined to the preamble.

Such limitations are significant because Windows NT is directed to a server environment which has vastly more resources available to it than the specific automotive environment claimed herein. Indeed, Microsoft uses *other* operating systems in connection with automotive environments, *i.e.*, Windows CE. *See* <http://msdn.microsoft.com/embedded/getstart/devplat/winauto/default.aspx> (attached hereto).

Accordingly, the combination posited by the Examiner to reject the remaining claims is not well-founded, and those claims should be allowable.

Additionally, Applicants have amended claim 34 as suggested by the Examiner, and now respectfully submits that claim 34 is in condition for allowance.

Because claims 1, 24 and 39 are patentable, claims 2-3, 6-21, 23, 25-33, 35-38 and 40-45 are patentable as dependent from patentable base claims. *See* MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Applicants respectfully request the entry of each of the foregoing amendments under 37 C.F.R. § 1.116 on the grounds that all claims are in condition for allowance or, alternatively, are in better condition for appeal.

Applicants respectfully submit that the amendment herein demonstrates Applicants' preference for particular language and, notwithstanding anything to the contrary, are not intended to be amendments related to patentability. Furthermore, Applicants respectfully submit that the amendments herein merely add language of equivalent scope, and that nothing herein is intended to narrow the scope of any of the claims.

The Commissioner is hereby authorized to charge any additional fees (or credit any overpayment) associated with this communication to our Deposit Account No. 13-0019. If a fee

is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such extension is requested and such fee should also be charged to our Deposit Account.

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